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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,283	11/24/2000	Frank A. Cardenas	4172P2241	3014
23504	7590	01/12/2006	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/718,283	<b>Applicant(s)</b> CARDENAS, FRANK A.	
	<b>Examiner</b> Yogesh C. Garg	<b>Art Unit</b> 3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment received on 10/24/2005 is acknowledged and entered. The applicant has amended claim 1, canceled claims 11-16 and added new claims 20-23. Currently claims 1-10 and 17-23 are pending for examination.

### *Response to Arguments*

2.1. Applicant's arguments, see pages 12-15, filed 10/24/2005, with respect to cited prior art references, Hoang, Roach & Greenstone have been fully considered and are persuasive. The rejection of claims 1-19 under 35 USC 103 (a) has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the prior art disclosed by Su (US Publication 2002/0026380 A1), Cohen and Weiss.

2.2. Applicant's arguments filed 10/24/2005 concerning cited reference Cohen, see page 14, lines 9-14 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner acknowledged that Cohen did not disclose returning the cash for unused portions and therefore combined the teachings of another prior art reference, Weiss.

2.3. Applicant's arguments filed 10/24/2005 concerning cited reference Weiss see page 14, lines 24-25, that the Weiss disclosure is a non analogous art, have been fully considered but they are not persuasive. In response to applicant's argument that the teachings of Weiss is

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nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the teachings of Weiss are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. The applicant was faced with the problem of returning the unused cash from a store card and Weiss discloses the solution to the same problem that is of redeeming balance amount of cash after using the player card. Therefore, in conformity with *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the teachings of Weiss are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

2.4. The examiner notes that the applicant has neither pointed out any errors nor demanded an evidence for the Official Notice taken in rejecting claim 8. Accordingly, the Noticed item was taken to be admitted prior art, see MPEP 2144.03 [R-1] C.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-7, 9-10 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Su, in view of Cohen and further in view of Weiss.

**Regarding claim 1**, Su teaches a system for secure and Private on-line shopping comprising, in combination:

Su discloses a store housing a plurality of computers, the store functioning as an on-line shopping store where individuals can order merchandise and have the merchandise delivered to the store for pick-up, one can enter a delivery location for the merchandise on one of the plurality of computers if delivery is not to the store (see at least paragraphs 0039-0049 7 Fig.1. In Fig.1, the ECS represented by "20", "20A"... correspond to the plurality of computers housed in a store "25". Also see paragraphs 0095-107 and Figs. 6-12 .)

an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site (see at least paragraphs 0039-0049 7 Fig.1. In Fig.1, the ESS "35" corresponds to an on-line shopping store server. ". Also see paragraphs 0095-107 and Figs. 6-12.)

Su does not disclose an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the

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monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers.

However, in the same field of endeavor, Cohen discloses an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers (see at least col.4, lines 16-48, "*Referring now to FIG. 1, a transaction system, generally designated 30, for handling purchasing transactions between a first party 31, typically a consumer, and a second party 33, typically a merchant, over a global computer network 32 such as the Internet is provided in accordance with a preferred embodiment of the present invention. The purchasing transactions are processed by a third party administrator 35. .... A plurality of pre-paid cards 34, which are generated by the third party administrator 35 and maintained at a distribution site 36, facilitate the purchasing transaction by providing a medium of exchange between the three parties. .... A pre-paid card purchasing option 50 is provided within such display site 40. Selection of the purchasing option 50 transfers the consumer 31 to the administrative computer 52 which generates a preformatted display page 102 (FIG. 8) substantially duplicating the merchant's display and handles the fund verification portion of the transaction. An administrative repository 62 and a merchant repository 64 further handle the transfer of funds between the parties. ....*" Note: The pre-paid card corresponds to the on-line store shopping card, the third party administrator 35 and the administrative computer 52 corresponds to a shopping on-line card server coupled to the on-line store server already disclosed by Hoang and analyzed above. This administrative computer verifies the authenticity and implements the crediting and debiting the monetary value of the on-line pre-

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paid shopping card and for transferring payments to the merchants/on-line retailers as claimed in the application).

In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Su as applied to claim 1 above to incorporate the features of an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a prepaid card having an assigned monetary value and a shopping card server coupled to the on-line shopping store server for verifying authenticity and monetary value of the on-line store shopping card, for crediting and debiting the monetary value of the on-line store shopping card, and for transferring payments to and from a user of the on-line store shopping card and the on-line retailers. Doing so would help : (1) to process the payment and close the transaction by using pre-paid debit cards, which would help in preventing credit card fraud, avoiding excessive debt, and (ii) further helping the retailer web sites by relieving them from the burden of verification/authentication process, processing payment, and fulfillment of the orders and therefore freeing the valuable resources of the retailer web site to focus on displaying and marketing their products/services.

Su/Cohen combined, as applied to claim 1 above, does not teach that individuals are able to return the on-line store card for cash on unused credit after shopping at the store. However, in the analogous field of cashless gaming system, Weiss teaches that individuals are able to return the on-line store card for cash on unused credit after shopping at the store (see at least, , col.4, line 53- col.5, line 58, " .....*Another further object of the present invention as characterized above which provides a player with the opportunity of opening an electronic account at an enrollment station and depositing funds into their account using cash, chips, a check or a marker. .... Another further object of the present invention is to provide a system as characterized above which includes providing secure playing cards to each individual who has opened an*

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*electronic account. ....Another further object of the present invention is to provide a system as characterized above which includes a redemption apparatus in which players may access their available account balances with their player cards and redeem these balances for cash and perquisite vouchers directly from the redemption apparatus.* ". Note: In Weiss, the player cards correspond to pre-paid on-line store cards in which the balances, that is the unused credit can be returned for cash after playing (corresponds to shopping in the claimed application. In the claimed application the user consumes the credit in the pre-paid store card for shopping and in Weiss the user consumes the credit in the pre-paid player card for playing. Also see col.1, lines 5-16, col.3, line 55-col.4, line 45, col.7, lines 47-58, and col.19, line 60-col.20, line 41).

In view of Weiss, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Su/Cohen, as applied to claim 1 above, to incorporate the feature of enabling consumers to return the on-line store card for cash on unused credit after shopping/playing at the store. By doing so the customers would have the flexibility to consume the credit balance of the card as per his or her requirement/liking and would not be forced to use the entire amount of the card against his wishes and further enable them to redeem the balance amount left in the card, as explicitly suggested in Weiss.

**Regarding claim 2,** Su/Cohen/Weiss combined as applied to claim 1 discloses at least one home computer coupled to the on-line shopping store server for accessing on-line retailers (see at least Su, paragraph 0041 & FIG.1, "60" user client computer corresponds to a home computer. The user client can be anywhere depending upon the user's location that is at home, office, etc.).

**Regarding claim 3,** Su/Cohen/Weiss as applied to claim 2 teaches a system for secure and private on-line shopping . Cohen further teaches comprising an outside server coupled to



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the on-line shopping store server and the on-line shopping card server for accessing web sites that not located on the on-line shopping store server (see at least col.7, lines 43-52, "*The third host is an administrative server 52 that communicates with the consumer host 39 and merchant host 41. Such administrative server ..... maintain an activation web site 42, generate and store preformatted displays 102, communicate with other network servers and a fund repository 62, verify the viability of a purchasing transaction, and maintain at least one transactional database 46 capable of storing a plurality of user records 44* ". Note: communicating with other network servers correspond to accessing web sites that not located on the on-line shopping store server). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Su/Cohen/Weiss as applied to claim 2 to incorporate the feature of accessing web sites that not located on the on-line shopping store server. Doing so would help : (1) to access bank servers/server of the issuer of the pre-paid cards to check the authenticity and (ii) further helping in connecting to other merchant sites to do comparison shopping as suggested in Cohen (see col.2, lines 5-8).

**Regarding claim 4,** Su/Cohen/Weiss as applied to claim 1 discloses that on-line retailers are formed into a single network of sites and are hosted on the on-line shopping store server (see at least FIG.1 and paragraphs 0039-0049. In Fig.1, "15" represents a shopping Mall having a plurality of stores, "10" which are connected via communication network "30" to the on-line shopping store server ESS "30". ).

**Regarding claim 5,** as applied to claim 1 discloses that the on-line shopping server host a home web page having hyperlinks to the on-line retailers (see Sue, at least paragraph 0096, disclosing that the ESS sending an e-shopping front, that is a Web page as shown in Fig.6 which have hyperlinks to on-line retailers ).

**Regarding claims 6 , 7, & 9**, Su/Cohen/Weiss as applied to claim 1 discloses that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card (see at least Cohen, FIG.3 which represents the shopping pre-paid card displays an identification number located on the card, col.4, line 49-col.5, line 3). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Su/Cohen/Weiss as applied to claim 1 to incorporate the feature that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card. Doing so would help : (1) to identify the pre-paid card and correlate it for verification/authentication so that payment can be transferred from the card to the merchant, and (ii) further helping the consumers to read the identification number from the card /or from a piece of paper like a printed receipt, as it is widely practiced when using the credit-cards.

**Regarding claim 10**, Su/Cohen/Weiss as applied to claim 1 also discloses that the on-line shopping card is a programmable on-line shopping card (see at least Cohen col.5, lines 30-36, " *expensive technology associated with so-called smart cards which typically include a chip or magnetic strip embedded into the card surface.....*". Note: The smart cards correspond to programmable on-line shopping cards. Here, Cohen discloses the use of smart cards, as an admitted prior art explicitly disclosing that information from these cards can be read by using a card reader and that information can include information about the user). In view of Cohen, it would have been obvious to a person of an ordinary skill in the art to have modified

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Su/Cohen/Weiss as applied to claim 1 to incorporate the feature of smart card because by doing so it allows an alternative to use IC-cards for receiving relevant information stored in the cards and also to store/transmit information to these smart cards, like adding monetary value, etc.

**Regarding claim 17**, Su/Cohen/Weiss as applied to claims 1 & 6 already covers the following limitations:

A method for making secure and private on-line purchases comprising the steps of:

Providing a store housing a plurality of computers, the store functioning as an on-line shopping store where individuals can order merchandise and have the merchandise delivered to the store for pick up;

providing an on-line shopping store server coupled to the plurality of computers of the on-line shopping store for hosting an on-line shopping store web site;

purchasing an on-line store shopping card for purchasing items from the on-line retailers wherein the on-line shopping card is a pre-paid card having an assigned monetary value and identification number;

entering the identification number of the on-line store shopping card;

verification of the identification number and funds remaining on the on-line store shopping card;

entering a delivery location of the goods and items purchased if delivery is not to the store when the identification number and funds are verified.

Su further discloses selecting goods and items to purchase (see paragraph 0096).

**Regarding claim 18**, Su/Cohen/Weiss as applied to claim 17 does not disclose the step of assigning a Personal Identification Number (PIN) to the on-line store shopping card.

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However, Cohen teaches this limitation (see Cohen at least col.8, lines 4-13, "*password 81*" corresponds to PIN.). In view of Cohen, it would have been obvious to one of an ordinary skill in the art at the time of the invention to have modified Su/Cohen/Weiss as applied to claim 17 to incorporate the step of assigning a Personal Identification Number (PIN) to the on-line store shopping card because it allows to authenticate the real user and to avoid fraudulent use of the shopping card.

**Regarding claim19**, Su/Cohen/Weiss as applied to claim 17 teaches a method for making secure and private on-line purchases and entering a delivery location of the goods and items purchased. Su/Cohen/Weiss as applied to claim 17 also discloses selecting the on-line shopping store as the delivery location (see at least paragraph 0095 disclosing that a shopper enters delivery of location the site of ECS 20, that is the shopping store from where he is doing the shopping.). Su further suggests calling a purchaser when the goods and items purchased have arrived at the on-line shopping store (see at least paragraph 0095 disclosing that a shopper enters delivery of location the site of ECS 20, that is the shopping store from where he is doing the shopping and the shopper is given the choice to decide upon seeing the goods if he wants to keep the products. The step of allowing the shopper to see the goods to make the choice of keeping the products would inherently include the step of calling a purchaser when the goods and items purchased by the shopper have arrived at the online shopping store.).

**Regarding claims 20-23**, their limitations are already covered in claims 1-7 & 17-19 or are closely parallel to them and are therefore, analyzed and rejected as being unpatentable over Su/Cohen/Weiss.

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4.2. Claim 8 is are rejected under 35 U.S.C. 103(a) as being obvious over Su/Cohen/Weiss as applied to claim 7 in view of an Official Notice.

Regarding claim 8, Su/Cohen/Weiss as applied to claim 7 discloses that the on-line shopping card has an identification number which is used when purchasing goods from the on-line retailers and the identification number is located on the on-line shopping card or on a piece of paper attached to the on-line shopping card. Su/Cohen/Weiss as applied to claim 7 does not disclose that the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape. The examiner takes an Official Notice of the well-known concept and benefits of covering the identification number located on the on-line shopping card is covered with a removable opaque adhesive tape for the obvious reason of not displaying it to the unauthorized people and in case if it has removed then it will indicate that the card has been tampered by unauthorized people and thereby caution the user to alert the concerned authorities.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,601,040 to Kolls discloses a wireless network system and method for allowing customer terminals to conduct electronic commerce from home or elsewhere such as in mall or fro inside of the physical stores (see at least Abstract. Note the digital devices such as PALM PILOT can be used anywhere).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
January 4, 2006